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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,818	08/22/2001	Jean-Michel Bernardon	016800-451	7237

7590

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EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,818

Applicant(s)

BERNARDON ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on July 11, 2002 in Paper No. 9 wherein claims 2 and 15-21 have been amended and claims 1 and 7 are cancelled. Currently, claims 2-6 and 8-21 are pending in this application.

Information Disclosure Statement (IDS)

Applicants' IDS submitted February 12, 2002 in Paper No. 8 is acknowledged. However, EP 0722928 has been crossed out as it is not appropriate for IDS, i.e., no translation provided.

It is merely noted for the record that claims 20-21 recites the limitation "formulation". There is insufficient antecedent basis for this limitation in the claim since claim 18 is not drawn to a formulation but tablets and capsules for example.

Applicant's remarks filed on July 11, 2002 in Paper No. 9 with respect to the objection of claims 7-8 made under 37 CFR 1.75 (c) for improper dependent for failing to further limit claim 12 of record stated in the Office Action dated February 12, 2002 have been fully considered and are found persuasive. Therefore, this objection is withdrawn.

Applicant's amendment (amending claims 2-6 and 8-21 and canceling claims 1 and 7) filed on July 11, 2002 in Paper No. 9, with respect to the rejections made under

Art Unit: 1617

35 U.S.C. 112 first paragraph for scope of enablement for the "chiral analogs" and "derivatives" and made under 35 U.S.C. 112 second paragraph for the expressions "chiral analogs" and "derivatives" in claims 1-21, of record stated in the Office Action dated February 12, 2002 has been fully considered and is found persuasive to remove the rejection since the expressions "chiral analogs" and "derivatives" have been removed. Therefore, the said rejections are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 and 8-21 are rejected under 35 U.S.C. 112, second paragraph, for indefinite expressions, for reasons of record stated in the Office Action dated February 12, 2002.

Applicant's remarks filed on July 11, 2002 in Paper No. 9 with respect to the rejection of claims 1-21 for the expression "regime or regimen" in claims 1-17 have been fully considered but are not deemed persuasive. As discussed in the previous Office Action, the claims are unclear as to whether a "regime or regimen" is considered as a composition or a method of treating. As indicated in the previous Office Action, in order to expedite prosecution, claims 1-17 have be examined as a composition as has apparently been intended (see page 5-6 in the specification herein). Thus, claims 2-6 and 8-17 as amended now are examined as a composition.

Art Unit: 1617

Applicant's remarks filed on July 11, 2002 in Paper No. 9 with respect to the rejection of claims 1-17 for the expression "such period of time...the desired response" in claims 1-2 have been fully considered but are not deemed persuasive. As discussed in the previous Office Action, the scope of the claims is indefinite as to what may be considered as the "desired response" and how long of "such period of time" is since the specification does not provide a standard for ascertaining the requisite degree.

Applicant's remarks filed on July 11, 2002 in Paper No. 9 with respect to the rejection for the expression "PPAR" in claims 7-8 have been fully considered. The examiner agree that "PPAR" is not a trademark/trade name. However, it is unclear as to what "PPAR" stands for. Therefore, the identification/description is indefinite.

Applicant's remarks filed on July 11, 2002 in Paper No. 9 with respect to the rejection of claims 9-12 for "compound (I) comprising at least one linear or branch alkyl radical..." in claim 9 have been fully considered but are not deemed persuasive. As discussed in the previous Office Action, it is unclear which substituent in the structural formula herein, i.e., R₁, R₂...or R₈ have this linear or branch alkyl radical in claim 9 or other groups in 10-12. Thus, the claims fail to clearly set forth the metes and bounds of the patent protection desired. Therefore, the scope of claims is indefinite as to the composition encompassed thereby.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1617

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-6 and 8-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernardon (5,763,487) for reasons of record stated in the Office Action dated February 12, 2002.

Applicant's remarks filed on July 11, 2002 in Paper No. 9 with respect to this rejection of claims 1-21 made under 35 U.S.C. 102(b) of record stated in the previous Office Action have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art for the following reasons.

Applicants argue that Bernardon patent does not contain all elements of the instant claims. However, as indicated in the previous Office Action, the instant claims have be examined as a composition as has apparently been intended (see page 5-6 in the specification herein). Applicant is requested to note that it is well settled that "intended use" of a composition or product, e.g., for treating disorders herein, will not further limit claims drawn to a composition or product. See, e.g., *In re Hack* 114, USPQ 161 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, a recitation of the intended use of a composition is not considered a limitation of the composition itself.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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Art Unit: 1617

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell S. Travers, J.D., Ph.D., can be reached on (703) 308-4603. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.
Patent Examiner, AU 1617
August 30, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200